

## **REMARKS**

The Office Action dated December 6, 2004, has been received and carefully considered. In this response, claims 1, 9, 11, 12 and 41 have been amended. Entry of the amendments to claims 1, 9, 11, 12 and 41 is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

### **I. THE INDEFINITENESS REJECTION OF CLAIMS 1-42**

On page 2 of the Office Action, claims 1-42 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. In particular, claims 1-42 were rejected “as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.”

Regarding claim 1, for example, the Office Action states as follows:

Claim 1 recites limitation (sic) “delivering the request to an automated interface” and then further recites “automatically rendering a decision on the request using the automated interface.” Since, there no (sic) attributes are provided which defines the nature of the request a decision on the request cannot be provided. Additionally, at least some processing of the request (the request having attributes such the customer account number, nature of the request etc.) must be performed using the attributes of the request to automatically render the decision. Therefore, it is asserted that the claim in the present form is deficient with respect to specific limitations which define the request received from the customer and processing of the request using the attributes of the request so that the decision is enabled. Note that the receiving step merely adjustment (sic) to the account as an intended or desired function but the request itself is not (sic) contain any attributes which would facilitate the adjustment to the account.

*See Office Action, Page 3, ¶ 1.<sup>1</sup>*

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<sup>1</sup> The Office Action also rejects claims 11, 12 and 41 as containing similar deficiencies as claim 1, and the dependent claims (2-10, 13-40 and 42) as inheriting the defects of their respective parent claims.

In support of the rejection, the Office Action references §2172.01 of the M.P.E.P. That section, however, clearly states that essential matter is matter which is described as such in the specification or in other statements of the record:

#### **2172.01 Unclaimed Essential Matter**

A claim which omits matter *disclosed to be essential to the invention as described in the specification or in other statements of record* may be rejected under 35 U.S.C. 112, paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 U.S.P.Q. 149 (C.C.P.A. 1976); *In re Collier*, 397 F.2d 1003, 158 U.S.P.Q. 266 (C.C.P.A. 1968). But see *Ex parte Nolden*, 149 U.S.P.Q. 378, 380 (Bd. Pat. App. 1965) ("[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result"); *Ex parte Huber*, 148 U.S.P.Q. 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly inter-cooperate, and/or serve independent purposes.)

(Emphasis added).

Applicants respectfully traverse this rejection and submit that neither the specification of the application nor the record describe or disclose *any* feature or function as being *essential to the invention*. In fact, the Office Action justifies the rejection of claim 1, for example, by merely stating that (1) the claim term "request" lacks defining attributes, making a decision on the request impossible, and (2) at least some "processing" of the request must be performed in order to render a decision, but does not indicate where such defining attributes and the processing step are disclosed or described as being essential to the invention. Applicants respectfully submit that without such a showing, the pending indefiniteness rejection cannot be maintained. *See, e.g.,*

M.P.E.P. § 2172.01 (“A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, paragraph, as not enabling.”) (emphasis added).

Further, Applicants respectfully submit that the other bases presented in the Office Action as supporting the indefiniteness rejection are also improper. For example, the Office Action asserts that the limitations of claim 7 “have no connection to the method steps performed by the service charge adjustment system,” and that claims 24, 27-28, and 33-39 fail to further limit any method steps of parent claim 2 because “all limitations...are performed independent of the properties of the automated interface. Setting aside the Office Action’s failure to indicate where the allegedly missing features are disclosed or described as essential to the invention, Applicants respectfully submit that interdependency of claim elements is not required under §112, second paragraph. *See, e.g., Ex parte Nolden*, 149 U.S.P.Q. 378, 380 (Bd. Pat. App. 1965) (“[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result”); *Ex parte Huber*, 148 U.S.P.Q. 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly inter-cooperate, and/or serve independent purposes.)

Accordingly, Applicants respectfully submit that the indefiniteness rejection of independent claims 1, 11, 12, and 41 -- and all claims that depend therefrom -- is improper and respectfully request that it be withdrawn.

## II. THE ANTICIPATION REJECTION OF CLAIMS 1, 2, 5, 6, 12, 15, 27 AND 28

On page 5 of the Office Action, claims 1, 2, 5, 6, 8, 12, 15, 27 and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fleming (U.S. Patent No. 5,953,710). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* “In addition, the prior art reference must be enabling.” *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” *Id.*

Although Applicants do not agree with the pending rejections, Applicants have nonetheless amended the claims to better recite the claimed systems and methods. In particular, independent claims 1, 11, 12 and 41 have been amended to recite that “the request for adjustment relates to a charge or fee posted against the customer’s account.” This amendment better recites the claimed systems and methods feature of receiving and processing adjustment requests associated with charges or fees that have been posted against the customer’s account. In contrast, Fleming relates to systems and methods that allow available credit to be determined by someone other than the card issuers and that allow a limit to be set on the number of expenditures that can be made. For example, Fleming teaches systems and methods that allow a parent to

regulate a child's use of a credit or debit card. As such, Applicants respectfully submit that there is no teaching or suggestion in Fleming of any feature or functionality that processes adjustment requests that relate to a charge or fee posted against the customer's account, as expressly recited in each of the independent claims. Accordingly, Applicants respectfully submit that independent claims 1, 11, 12 and 41, as amended, are allowable over the cited references.

Claims 2-10, 13-40 and 42 are dependent upon independent claim 1, 12 or 41. Thus, since independent claims 1, 12 and 41 should be allowable as discussed above, claims 2-10, 13-40 and 42 should also be allowable at least by virtue of their dependency on independent claim 1, 12 or 41. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, dependent claim 9, as amended, recites the apparatus of claim 8 wherein the automated interface is operable to perform each of the following: validating the existence of a service charge; determining the cost-effectiveness of granting the request; checking to see if the customer has a special status; determining if a bank error has occurred; checking to see if the customer is a high value customer; rating the profitability of granting the request; checking to see if the customer has made at least a predetermined number of previous requests; ascertaining if the customer has been granted at least one courtesy adjustment; and determining if the request is justified. Applicant respectfully submits that Fleming does not teach or suggest any feature or functionality that is operable to perform each of these steps.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 2, 5, 6, 8, 12, 15, 27 and 28 be withdrawn.

### III. THE OBVIOUSNESS REJECTION OF CLAIMS 3-4, 7, 9-11, 13, 14, 16-26 AND 29-42

On page 8 of the Office Action, claims 3-4, 7, 9-11, 13, 14, 16-26 and 29-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fleming in view of Official Notice. This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the pending obviousness rejection has been overcome for at least the reasons set forth above in connection with the anticipation rejection of claims 1, 2, 5, 6, 8, 12, 15, 27 and 28.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 3-4, 7, 9-11, 13, 14, 16-26 and 29-42 be withdrawn.

### IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the

present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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